Remarks/Arguments

The present amendment is made in response to the Office Action dated April 16, 2010, and identified as Paper No. 20100331. Claims 1-12 are pending in the present application. In the Action, the Examiner rejected claims 1-3, 5-7, 9-10 and 12 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,278,979 to Williams (*"Williams"*). Claims 4 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams* in view of European Patent No. 1,253,511 to Korst (*"Korst"*). Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams* in view of U.S. Patent No. 6,415,341 to Fry (*"Fry"*).

I. Rejection of Claims 1-3, 5-7, 9-10 and 12 Under 35 U.S.C. §102(b)

The Examiner rejects claims 1-6, 8-11, 13-17, and 19-20 as being anticipated by *Williams*. A rejection under 35 USC 102(b) requires that the reference include each and every limitation recited in the claims. *See* MPEP 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Applicant submits that not all of the elements of the rejected claims are disclosed by *Williams*, as further explained below; thus the claims are not anticipated.

In particular, Applicant submits that *Williams* does not teach or suggest at least the steps of "identifying a triggering byte string to act as a trigger for indicating the suspension of printing of said special effect on said output media," determining whether said input byte stream includes said triggering byte string," and "suspending the printing of said special effect in response to determining said triggering byte string is in said input byte stream," as required by the independent claims of the present application.

1. *Williams* does not teach the step of "identifying a triggering byte string to act as a trigger for indicating the suspension of printing of said special effect on said output media"

The Examiner asserts that *Williams* teaches the step of "identifying a triggering byte string to act as a trigger for indicating the suspension of printing of said special effect on said output media" at col. 14, line 60- col. 15, line 11:

> "Maintenance of the controller files used in coupon creation and redemption is effected by means of a sequential maintenance file which may be prepared at a site remote from the store, and then processed at the store controller to effect the desired changes in the files. The maintenance functions include (1) adding, deleting, or replacing coupon deal records and coupon index records, (2) enabling and disabling coupon triggering by item, (3) enabling and disabling coupon printing by item,(4) copying the coupon by file, and (5) retrieving the coupon counts. Other functions include (1) reorganizing the coupon-look-up file, (2) clearing the file before a reload, and (3) adding or replacing system configuration data. The latter function includes (1) enabling or disabling coupon creation by coupon deal, (2) enabling or disabling printing by store or checkout lane, (3) enabling or disabling coupon validation but continuing to log redemptions and misredemptions, (4) updating a per-transaction coupon maximum, by checkout lane, and (5) updating a transaction threshold."

Rather than describe a process of identifying a byte string in the input stream that causes the suspension of printing of a special effect (such as a pre-configured legacy graphic) on output media, this section of *Williams* refers to remote maintenance of controller files. There is no mention in this or any other section of *Williams* of identification of a byte string in the input stream that causes actions on the input stream or to the printout. The system taught by *Williams* appears to be similar to the prior art of POS printers as described in the "Description of Prior Art" section of the present application:

> "However, the automatic insertion of graphics creates another need, as there usually are a small number of receipts issued during a day that should not have some of the configured graphics printed on them. This translates into a requirement that the printer control the insertions. As the insertion of the graphic enhancements was often set up at a distant configuration time, there is a need for

additional control of the configured graphics, so that any (or all) of the configured actions can be temporarily suppressed." Paragraph [0014].

Therefore, *Williams* appears to describe a traditional process by which the printing is "set up at a distant configuration time," and thus does not teach a process similar to that claimed in the present application.

2. *Williams* does not teach the step of "determining whether said input byte stream includes said triggering byte string"

The Examiner asserts that *Williams* teaches the step of "determining whether said input byte stream includes said triggering byte string" at col. 2, lines 26-55:

> "The present invention provides an apparatus, and a related method, for printing a discount coupon or other like incentive at a transaction terminal. In general terms, the apparatus of the invention comprises means for identifying a triggering transaction and means for printing a coupon or other like incentive having a border with or without a watermark. The bordered incentive or coupon is printed in response to the nature of the transaction--i.e., products purchased or not purchased, cash tendered for payment, or a credit or debit card, etc. The color of the border can be any color. Other non-triggering transactions can result in the printing of coupons or other like incentives not having borders. Also, in both scenarios, the transaction receipt can be printed without a border from the same printer that printed the coupons and other like incentives having borders.
>
> "Another embodiment of the present invention provides an apparatus, and a related method, for printing a redeemable discount coupon at a point of sale terminal. In general terms, the apparatus of the invention comprises means for identifying a triggering product in a customer order, means for associating the triggering product with a coupon deal, and means for automatically printing at least one discount coupon having a border. The coupon having a border is printed in response to either (1)the purchase of a certain product or (2) the fact that the customer did not purchase a certain product or (3) other triggering aspects of the order have been met such as type of tender type or amount, loyalty card use, etc. Other coupons which are not triggered by products bought or not bought can be printed which do not have a border."

The claims recites the step of "determining whether said input byte stream includes said triggering byte string." In other words, "determining whether said input byte stream includes [a triggering byte string to act as a trigger for indicating the suspension of printing of said special

effect on said output media]." As stated above, *Williams* does not identify this triggering byte, and thus does not determine whether the input stream includes the triggering byte string. Instead, this section of *Williams* appears to teach a process by which the apparatus identifies a pre-programmed triggering transaction and based on the transaction type it prints a pre-programmed output. Thus, rather than suspend printing of a special effect, the apparatus of *Williams* appears to print the pre-programmed special effects which are associated with that particular transaction type.

3. *Williams* does not teach the step of "suspending the printing of said special effect in response to determining said triggering byte string is in said input byte stream"

The Examiner asserts that *Williams* teaches the step of "suspending the printing of said special effect in response to determining said triggering byte string is in said input byte stream" at col. 14, line 60- col. 15, line 11:

> "Maintenance of the controller files used in coupon creation and redemption is effected by means of a sequential maintenance file which may be prepared at a site remote from the store, and then processed at the store controller to effect the desired changes in the files. The maintenance functions include (1) adding, deleting, or replacing coupon deal records and coupon index records, (2) enabling and disabling coupon triggering by item, (3) enabling and disabling coupon printing by item,(4) copying the coupon by file, and (5) retrieving the coupon counts. Other functions include (1) reorganizing the coupon-look-up file, (2) clearing the file before a reload, and (3) adding or replacing system configuration data. The latter function includes (1) enabling or disabling coupon creation by coupon deal, (2) enabling or disabling printing by store or checkout lane, (3) enabling or disabling coupon validation but continuing to log redemptions and misredemptions, (4) updating a per-transaction coupon maximum, by checkout lane, and (5) updating a transaction threshold."

First, since *Williams* does not identify the triggering byte string, it similarly does not suspend the printing of a special effect in response to determining that the triggering byte string is in the input byte stream. Second, rather than discuss a process of suspending the printing of a

special effect in response to determining that the triggering byte string is in the input byte stream, this section of *Williams* refers to remote maintenance of controller files. There is no mention in this or any other section of *Williams* of suspension of printing of a special effect in response to a triggering byte string. Instead, *Williams* appears to describe a traditional process by which the apparatus identifies a pre-programmed triggering transaction and based on the transaction type it prints a pre-programmed output. Thus, rather than suspend printing of a special effect, the apparatus of *Williams* appears to print the pre-programmed special effects which are associated with that particular transaction type.

Since *Williams* does not disclose every element of the instant invention, Applicant respectfully requests that the rejection of claims 1-3, 5-7, 9-10, and 12 under 35 U.S.C. §102(b) be withdrawn.

II. Rejection of Claims 4, 8, and 11 Under 35 U.S.C. §103(a)

Claims 4 and 11 were rejected as being unpatentable over *Williams* in view of *Korst*, and claim 8 was rejected as being unpatentable over *Williams* in view of *Fry*.

Regarding claims 4 and 11, the Examiner asserts that while *Williams* fails to disclose wherein said triggering byte string is a legacy text string, *Korst* does teach such a limitation. However, for the reasons detailed above the combination of *Williams* and *Korst* fails to remedy the many deficiencies of *Williams*, and thus fails to render claims 4 and 11 obvious. Accordingly, Applicant respectfully requests that the rejection of claims 4 and 11 under 35 U.S.C. §103(a) be withdrawn.

Regarding claim 8, the Examiner asserts that while *Williams* fails to disclose the step of managing said non-volatile storage to hold a fixed number of byte strings, *Fry* does teach such a limitation. However, for the reasons detailed above the combination of *Williams* and *Fry* fails to

remedy the many deficiencies of *Williams*, and thus fails to render claims 4 and 11 obvious. Accordingly, Applicant respectfully requests that the rejection of claim 8 under 35 U.S.C. §103(a) be withdrawn

III. Conclusion

In view of the amendments made herein as supported by these foregoing remarks, the Examiner's reconsideration is respectfully requested. Should the Examiner believe an interview would expedite prosecution of this application, please contact the undersigned at 315-218-8515.

Respectfully submitted,

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